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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,804	02/24/2004	Takuya Hara	X2007.0151	9748
32172	7590	03/01/2006	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMERICAS (6TH AVENUE) 41 ST FL. NEW YORK, NY 10036-2714			RODRIGUEZ, JOSEPH C	
		ART UNIT		PAPER NUMBER
				3653
DATE MAILED: 03/01/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/784,804	HARA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Joseph C. Rodriguez	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 24 February 2004 is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    - 1) Certified copies of the priority documents have been received.
    - 2) Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    - 3) Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 2/24/04.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-8 and 13-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

These claims recite the limitation "the transport unit". There is improper antecedent basis for this limitation because Applicant has previously defined a "transport unit" and a "secondary transport unit".

Examiner recommends defining a "first" and "second" transport unit to avoid confusion.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –  
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Liu et al. ("Liu") (US 6,294,747).

Regarding claims 1, 6, 8, Liu teaches a work screening apparatus (Fig. 1-16) comprising:

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a slope way (chute 29) for sequentially transporting a plurality of works; a transport unit equipped with a plurality of work holding spaces (Fig. 4, 6, 7; transfer wheel with a plurality of cavities 23 at prescribed pitches therebetween), so that the plurality of works sequentially transported via the slope way are independently held in the plurality of work holding spaces (Abstract teaching that each cavity holds one work), wherein a leap inhibiting wall (9, 25) is arranged at a prescribed position between the slope way and the work holding space so as to inhibit each of the works from leaping outside therefrom; and

a discharge unit (Fig. 11, 13; air ejector 101, 125) for automatically discharging the plurality of works transported thereto from the transport unit at a prescribed discharge position in response to inspection results thereof produced by an inspection apparatus (col. 6, ln. 53 – col. 7, ln. 42). Further, Applicant is respectfully reminded that claim language consisting of functional language and/or intended use phrasing is given little, if any, patentable weight as the apparatus must merely be capable of functioning, or being used, as claimed. See MPEP 2112.02, 2114. Here, the device is certainly capable of transporting works for which inspection has been completed by an inspection apparatus and discharging the works based on the results therefrom.

Regarding claims 2, 3, 5, 7, Liu teaches that the plurality of works are sequentially put into the plurality of work holding spaces independently in accordance with rotation of the transport unit (col. 4, ln. 13-col. 5, ln. 29), which includes a secondary transport unit (screening table 65) having a planar portion for receiving the plurality of works transported thereto and for further transporting the

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plurality of works towards the prescribed discharge position (col. 5, ln. 30-col. 6, ln. 19 teaching that transport units are at the same perimeter speed to allow for transfer onto outer periphery of screening table), and

    said transport unit is installed in a hollow of a housing so that each of the work holding spaces is defined between a circumferential wall of the hollow and a bottom of the hollow (Fig. 4, 6), and wherein an upper surface of the secondary transport unit is set substantially a same height as the bottom of the hollow, and an opening is formed to partially cut out the circumferential wall of the hollow to communicate with the secondary transport unit, and the opening of the hollow is arranged just above the upper surface of the secondary transport unit (Fig. 8 showing gap between first and second transport units; col. 5, ln. 30-col. 6, ln. 19).

Regarding claim 4, Liu teaches an escape channel (Fig. 8, 10 channel near 91) arranged in the transport unit so as to allow the work to escape towards a downstream side as the transport unit rotates, so that the work that fails to be transported to the secondary transport unit is discharged outside of the transport unit (col. 6, ln. 18-34).

Regarding the method step in claim 10, Liu teaches the transference in bulk of the chips down a vibrating chute and "gently depositing" said chips on the upper surface of the transport wheel prior to transferring the chips to the second transport unit (col. 4, ln. 40-col 6., ln. 18). Thus, it is implicit that a time period in which the plurality of work holding spaces move by one pitch is set shorter than a time interval in which each of the works is transported via the slope way. That is, if the time period was longer than the first transport unit would be overloaded with chips from the vibrating chute.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Liu in view of Applicant's Admitted Prior Art.

Liu as set forth above teaches all that is claimed except for expressly teaching said works being completed in inspection prior to transport. Applicant, however, already teaches that it is known to completely inspect works prior to transport to the rotary screening table (Spec., p. 1). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the invention of Liu with the completed inspection of the works as Applicant already teaches that this modification is well known.

***Conclusion***

Any references not explicitly discussed above but made of record are considered relevant to the prosecution of the instant application.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Joseph C Rodriguez** whose telephone number is **571-272-6942** (M-F, 9 am – 6 pm, EST).

The **Official** fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

The examiner's **UNOFFICIAL Personal fax number** is **571-273-6942**.

Further, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system.

Status information for published applications may be obtained from either Private PMR or Public PAIR. Status information for unpublished applications is available through Private PMR only.

For more information about the PAIR system, see

<http://pair-direct.uspto.gov>

Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at **866-217-9197** (Toll Free).

Alternatively, inquiries of a general nature or relating to the status of this application or proceeding can also be directed to the **Receptionist** whose telephone number is **571-272-6584** or to the Supervisory Examiner, Kathy Matecki, **571-272-6951**.

Signed by Examiner Joseph Rodriguez

Jcr

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February 27, 2006

A handwritten signature in black ink, appearing to read "J. C. Rodriguez".